



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,678	09/21/2001	John R. Fredlund	83415RLO	5258

7590 10/20/2005

Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

CARBONELLO, MICHAEL J

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/960,678	Applicant(s) FREDLUND ET AL.	
	Examiner Michael Carbonello	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/14/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-9/21/01,09/04/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 8/22/05, and has been entered and made part of record, claims 1, 3-7, and 9 are pending.

Response to Arguments

2. Upon review of the current amendments, and the current art of record, the examiner believes that the references of Fredlund et al (5,666,215), Schroeder (6,005,988), and Roberts et al (6,094,219) can still be interpreted as obvious at the time of invention.

3. Applicant's arguments, filed 8/22/2005, have been fully considered, but they are not persuasive.

4. In response to applicant's arguments 8/22/2005, regarding claim one, which was previously cited in the office action filed 07/29/2005, as being obvious of Fredlund et al in view of Roberts et al and Schroeder. The applicant is correct that Roberts et al does disclose a resolution switch in 14A in fig. 6, and does provide functionality as described. However, the applicant has misinterpreted the examiner's usage of Roberts. The examiner never disclosed the use Roberts for any sort of digital image resizing, but rather as means to simply generate digital images. The examiner contends that it would have been obvious at the time of invention to use the method taught by Fredlund et al, and to simply substitute the method and devices taught by Roberts to generate digital images. This new combination would replace process described by Fredlund et al whereby a user a submits negatives, the photofinisher develops the negatives, scans

the negatives into a digital format, stores the negatives in a mass storage device, and then transmits, either electronically or via mail, the images to the user. The obviousness is derived from the fact that digital images devices, such as digital cameras, had been widely at the time of invention, (and at the very least were prior art). Further the digital camera produces a functionally equivalent result, a high-resolution digital image.

Therefore, the examiner still believes that would it would have been obvious at the time of invention for one of ordinary skill in the art to combine Fredlund et al with Roberts as means to generate digital images.

5. Further, the combination of Schroeder et al with Fredlund and Roberts is used as a method by which digital images are converted from a higher resolution to a lower resolution automatically. The examiner does not feel this is hindsight because Schroeder et al has been of public record at least as long as 1999, which at the very least proves that image resizing of digital images through modifying pixels, is not a new concept. Also products like WINZIP, which are used to compress files, (or shrink files) down to a smaller size to make transferring them easier are not a new concept either.

6. Next, as was disclosed in the Office action dated 07/29/2005, the photos themselves are the image bearing image-bearing products. The photos are a type of product, and the image on the photo makes them an image-bearing product. The ability to choose which pictures are to be purchased is the ability to select an image-bearing product from a plurality of image bearing products. Moreover, the office action discloses the ability to select size and quantity (Column 2, lines 23 –27). Lastly, the differently sized digital images would require different size resolutions as is known in the art.

7. Since the applicant claims resizing happens "automatically" there is no need to communicate that information to the user, since the user would have no control over it anyway. Disregarding that information, the resizing does not happen automatically, the resizing happens as the result of a user choosing an image-bearing products as is disclosed by the applicant. This is disclosed in claims 1c-1e, where a user selects a product, the service providers communicates the resolution required, then the image is resized. Since Schroeder et al teaches a method that is similar to the method taught by the applicant; that being resizing images through modifying bits per pixel, it would have been obvious at the time of invention to combine Schroeder et al with Fredlund et al and Roberts to disclose the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund in view of Schroeder and Roberts. Regarding claim 1, Fredlund discloses a method of selecting products and services (Column 2, lines 22-27), a service provider providing information, which is displayed at the first location, information being displayed by transmitting the file over a communications link (Column 2, lines 31-37), including at least two different image bearing products that can be provided by the service provider (Column 2, lines 23 and 24), and the customer is able to select the

images and services and order the desired number and size of prints to be provided by the service provider after viewing the displayed images (Column 2 lines 31-40). With respect to claims 1b and 1c, the photographic images being ordered by the customer are a type of image-bearing products. Fredlund also discloses sending photographic photo film to the photofinisher (Column 2, line 28).

Fredlund does not disclose the user providing a high-resolution digital image, the service provider communicating the resolution required for the selected image-bearing product. He does also does not disclose, responsive to the communicated required resolution automatically converting at the first location the high resolution digital image to a lower resolution digital image corresponding to the selected image bearing product, sending the lower resolution digital image from the first location to the service provider and utilizing the lower resolution digital image to produce the selected image bearing product.

Roberts et al discloses in Column 2, lines 16-20; "It is a further object of this invention to provide an improved electronic still camera that provides digital image files for immediate and direct incorporation into popular word processing, desktop publishing, and other software programs on PCs."

Schroeder discloses in Column 1, lines 33-35; "a method for resizing digital images that is simple, fast, very flexible and very accurate."

It would have been obvious at the time of the invention to one of ordinary skill in the art to combine Fredlund, Roberts et al and Schroeder. The motivation of combining Fredlund with Roberts is that the service provider no longer needs to develop negatives

or scan images into a digital format for image bearing products, reducing both time and money, but is still able to utilize all of the editing tools because the image being provided by the user is also in a digital format. It allows customers to provide their own plurality of digital images, which can easily be viewed, edited, deleted and stored without having to purchase film, submit negatives or wait for the photofinisher to develop the images for use with the image bearing products. Further, combining Fredlund and Roberts with Schroeder would provide all the functionality previously described but also adds the extra feature of resizing (shrinking) the image as required by the image-bearing product. Thus providing for a shorter transfer time as the images are sent via a communications link to the service provider.

2. Regarding claim 3 Fredlund, Roberts and Schroeder disclose the method discussed above in claim 1, and Roberts further teaches in Column 2, lines 16-20; "It is a further object of this invention to provide an improved electronic still camera that provides digital image files for immediate and direct incorporation into popular word processing, desktop publishing, and other software programs on PCs." It would have been obvious at the time of invention to one of ordinary skill in the art to use a digital camera to capture digital images. The motivation of using a digital camera over traditional image processing techniques is that the service provider retains the ability to provide the same photofinishing services to the customer, but is no longer required to develop negatives, scan the images into a digital format or store the customer's images, which saves time and money.

3. Regarding claim 4 Fredlund, Roberts and Schroeder disclose the method discussed above in claim 1, Fredlund Further teaches in Column 2 lines 23 -27; “enables a customer to select size, quantity, destination, text, frames and other options associated with photographic prints.” It would have been obvious at the time of invention to one of ordinary skill in the art for to provide image-bearing products where at least two of the products are prints of different sizes. The motivation of providing different sized prints is that resizing digital images is quick and easy compared to traditional photographic development techniques, and it allows the service provider to provide additional products and services.

4. Regarding claim 5, Fredlund, Roberts and Schroeder disclose the method discussed above in claim 1, Fredlund Further teaches in Column 2 lines 23 -27; “enables a customer to select size, quantity, destination, text, frames and other options associated with photographic prints.” Using the broadest interpretation of term “photo album” a collection of images is a photo album. It would have been obvious at the time of invention for one of ordinary skill in the art to provide the user with different collections of images with different sizes, quantities, texts, frames and other options where at least two of the image bearing products are photo albums. The motivation for providing photo albums is that photo albums are an efficient method of storing, sorting, labeling and viewing images.

5. Regarding claims 6 and 7, Fredlund, Roberts and Schroeder disclose the method discussed above in claim 1, Fredlund Further teaches in Column 2 lines 37-44; “The customer then selects images and services and orders the desired number and size of

prints and other image related services for the selected images, and designates a recipient for the order. The designated recipient may be different from the customer placing the order. The photofinisher completes the order and sends the prints to the designated recipient and sends the bill to the customer or charges the customer's credit card account." It would have been obvious at the time of invention for one of ordinary skill in the art to create a user account to provide the user with access to the ordered products and services and also provide a method of payment of the selected products and services. The motivation of establishing an account with the user is that it allows the service provider to accurately display each individual user its own personal account and service information. The benefit of providing a method of payment is that allows the provider to establish a quick and effective method to receive compensation for goods and services.

6. Regarding claim 9 Fredlund, Roberts and Schroeder disclose the method discussed above in claim 1, Schroeder further teaches in column 1, lines 33-35; "a method for resizing digital images that is simple, fast, very flexible and very accurate." It would have been obvious at the time of invention for one of ordinary skill in the art to utilize a method that resizes the digital images submitted by the user by to create a lower resolution image. The motivation for converting a high resolution into a lower resolution image is to decrease the transfer time between the user and the service provider when a lower resolution image is required for certain image bearing products.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sasai discloses a method of scaling images. Gindele discloses a method of producing a low-resolution image from a sparsely sampled extended dynamic range digital image. Aas discloses "a method for automatically scaling an Image."

THIS ACTION IS MADE FINAL.

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Carbonello whose telephone number is (571) 272-0625. The examiner can normally be reached on Monday through Friday between 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Carbonello
Examiner
Art Unit 2622

MJC

JOSEPH R. POKRZYWA
PRIMARY EXAMINER
ART UNIT 2622
